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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
TATE, CHRISTOPHER ROBIN

ART UNIT	PAPER NUMBER
1654	

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/089,157	HWANG, JAEKWAN	
	Examiner	Art Unit	
	Christopher R. Tate	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *18 August 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4* is/are pending in the application.

4a) Of the above claim(s) *3 and 4* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 2* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *0502* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Applicant's election with traverse of Group I, claims 1-2, is acknowledged. The traversal is on the ground(s) that the Office has merely stated a conclusion concerning the lack of unity but has not provided reasons why unity of invention is lacking and, further, the search for all inventions would not impose a serious burden on the Office. This is not found persuasive because, as discussed in the previous Office action, the special technical feature of the Group I invention is a ginseng dietary fiber product produced by a series of steps - which is/are lacking from the Group II invention. The special technical feature of the Group II invention is a ginseng oligosaccharide product produced by a series of process steps - which is/are lacking from the Group I invention. Please note that the special technical feature of the first ginseng product (Group I) is that it is a ginseng dietary fiber product, which is totally lacking from the second ginseng product (Group II); whereas the special technical feature of the Group II product is that it is a ginseng oligosaccharides product, which is totally lacking from the first ginseng product. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious the other group. Thus, it would be an undue burden to examine all of the above inventions in one application.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-2 are presented for examination on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rendered vague and indefinite for the following reasons:

- In step (c), the phrase "adding the result of step (b) to water to prepare a sample with a concentration of 1~10% (w/v)" is unclear and confusing – e.g., is the water being added to some result (?) of step (b) so as to provide a sample having this concentration range of water therein, having this concentration range of the result (?) of step (b) therein, or something else? Further, the phrase "the result" lacks antecedent basis. It is suggested that step (b) be expanded at the end to recite --to obtain an extruded ginseng residue-- (or similar phraseology) and that the above phrase in step (c) be amended to recite --adding the extruded ginseng residue of step (b) to water at a concentration of 1~10% (w/v)-- to clarify this ambiguity.
- Steps (d) and (e) recite "and preparing water-insoluble ginseng dietary fiber" and "and preparing water-soluble ginseng dietary fiber", respectively, both of which are vague and indefinite – e.g., it is unclear if these are actually intermediate and final product limitations with respect to the process steps recited in steps (d) and (e), or if they are attempting to defining future

preparation steps. It is suggested that these phrases be amended to recite -- to obtain water-insoluble ginseng dietary fiber-- and --to obtain water-soluble ginseng dietary fiber--, respectively.

- In step (e), the phrase "filtering a supernatant obtained by centrifugation in step (c)" is vague and indefinite because it is unclear if the water-insoluble ginseng dietary fiber prepared in step (d) is actually being further processed by this phrase. It is suggested that this phrase be amended to recite --filtering the water-insoluble ginseng dietary fiber obtained in step (c) --.

- For clarity (and based upon the teachings of the instant specification), it is suggested that the preamble reflect the actual final product obtained by the overall process of claim 1 – i.e. (in line 1), expanding the preamble to recite --A process of preparing a water-soluble ginseng dietary fiber-- so as to concur with the final product (and instant teachings) actually obtained by the claim 1 process.

Claim 2 depends from claim 1 and is, therefore, also rejected under USC 112, second paragraph for the reasons set forth above.

Claim Rejections - 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Han et al. (KR 95-26392 - IDS Abstract provided by Applicants).

A ginseng dietary fiber is claimed (as a product-by-process).

The cited reference discloses a dietary fiber which appears to be identical to the presently claimed dietary fiber, since it was also obtained from ginseng.

In the alternative, even if the claimed ginseng dietary fiber is not identical to the referenced ginseng dietary fiber with regard to some unidentified characteristics, the differences between that which is disclosed and that which is claimed are considered to be so slight that the referenced ginseng dietary fiber is likely to inherently possess the same characteristics of the claimed ginseng dietary fiber particularly in view of the similar characteristics which they have been shown to share. Thus, the claimed ginseng dietary fiber would have been obvious to those of ordinary skill in the art within the meaning of USC 103.

Accordingly, the claimed invention as a whole was at least prima facie obvious, if not anticipated by the reference, especially in the absence of sufficient, clear, and convincing evidence to the contrary.

With respect to the USC 102/103 rejection above, please note that the Patent and Trademark Office is not equipped to conduct experimentation in order to determine whether Applicants' ginseng dietary fiber differs and, if so, to what extent, from that disclosed by the cited reference. Therefore, with the showing of the reference, the burden of establishing non-obviousness by objective evidence is shifted to the Applicants.

Claim Rejections - 35 USC § 103

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hwang et al. (IDS reference: KR 97-0013 – full English Translation enclosed) in view of Han et al. (KR 95-26392 - IDS Abstract provided by Applicants).

Hwang et al. beneficially teach the preparation of dietary fiber from plant material via extrusion essentially within the instantly claimed working parameters (as best understood) - see translation. Hwang et al. do not expressly teach utilizing ginseng plant material in their process.

Han et al. beneficially teaches that dietary fiber can advantageously be obtained from ginseng (white ginseng) - see IDS Abstract.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to utilize ginseng as a dietary fiber plant source within the dietary fiber plant extrusion process taught by Hwang et al. based upon the beneficial teachings provided by Han et al. with respect to ginseng being a good source of dietary fiber. The result-effective adjustment of particular conventional working conditions (e.g., adjusting conventional extrusion and/or extraction parameters), is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

Thus, the invention as a whole is prima facie obvious over the references, especially in the absence of evidence to the contrary.

Conclusion

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (703) 305-7114. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached at (703) 306-3220. The Group receptionist may be reached at (703) 308-0196. The fax number for art unit 1654 is (703) 872-9306.

Christopher R. Tate
Primary Examiner, Group 1654